



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/767,961      | 01/24/2001  | Tatsuya Takaoka      | P100158-00024       | 2795             |

23353 7590 03/07/2003

RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036

EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 03/07/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                  |  |
|------------------------------|-------------------------------|----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/767,961 | Applicant(s)<br>TAKAOKA, TATSUYA |  |
|                              | Examiner<br>John L. Goff      | Art Unit<br>1733                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1733

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, claims 1-3, in Paper No. 8 is acknowledged.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In claim 1, the phrase "while forming a space for absorbing variations in an amount of extrusion of the rubber strip between said guide roll and an extrusion outlet of said injection device" is unclear and confusing. Does it mean that pressing the rubber strip by a guide roll against the forming drum increases the distance between the guide roll and the extrusion outlet, i.e. the guide roll moves away from the extrusion outlet during pressing? This issue should be clarified and reworded as appropriate.

Art Unit: 1733

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Stevens (U.S. Patent 4,371,410).

Stevens is directed to a method for wrapping a rubber strip around a forming drum (guide). Stevens teaches the method comprises extruding a rubber strip, placing the rubber strip around a guide roll (applicator roll), actuating the guide roll toward the forming drum such that the rubber strip contacts the guide roll and a space is formed between the guide roll and the entry of the extruded strip, rotating the forming drum so that the guide roll is driven and the rubber strip is wrapped around the forming drum, releasing the guide roll from the forming drum such that a clearance is formed between the guide roll and the forming drum, severing the rubber strip in the clearance, and pressing the severed end of the rubber strip against the forming drum using a press (stitching) roll (Figures 1-3 and Column 2, lines 16-19 and Column 3, lines 10-14, 27-39, and 46-63)

Art Unit: 1733

***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Satoh et al. (U.S. Patent 5,059,268).

Stevens is directed to a method for wrapping a rubber strip around a forming drum (guide). Stevens teaches the method comprises extruding a rubber strip, placing the rubber strip around a guide roll (applicator roll), actuating the guide roll toward the forming drum such that the rubber strip contacts the guide roll and a space is formed between the guide roll and the entry of the extruded strip, rotating the forming drum so that the guide roll is driven and the rubber strip is wrapped around the forming drum, releasing the guide roll from the forming drum such that a clearance is formed between the guide roll and the forming drum, severing the rubber strip in the clearance, and pressing the severed end of the rubber strip against the forming drum using a press (stitching) roll (Figures 1-3 and Column 2, lines 16-19 and Column 3, lines 10-14, 27-39, and 46-63).

Regarding claim 2, it is noted Stevens recites severing the rubber strip and does not explicitly recite cutting. However, cutting only requires "to penetrate with or as if with an edged instrument" (See Webster's), and thus, severing the rubber strip would include the same as cutting the rubber strip. In any event, one of ordinary skill in the art at the time the invention was made would have readily appreciated cutting the rubber strip taught by Stevens using an

Art Unit: 1733

edged instrument as it was well known in the art to do so as shown for example by Satoh et al. and only the expected results would be achieved.

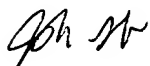
Satoh et al. are directed to a method of applying a rubber strip to a forming drum using an actuated guide roll (applying roller). After the rubber strip is wrapped around the forming drum, Satoh et al. teach disengaging the guide roll and cutting the rubber strip using a pair of knives (Figure 1 and Column 4, lines 42-57 and Column 5, lines 64-68 and Column 6, lines 1-2).

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John L. Goff  
March 3, 2003



Michael W. Ball  
Supervisory Patent Examiner  
Technology Center 1700